

REMARKS

With entry of this amendment, claims 70, 72-79, and 81-87 are pending in this application. Of these, claims 70 and 72-78 have been allowed, claims 79 and 81-84 stand rejected, and claims 85-87 have been newly added. Based on the foregoing amendments and following remarks, reconsideration and allowance of this application is respectfully requested.

Specification Objections-Abstract

The abstract stands objected to as exceeding the 150 word limit. The previous abstract has been accordingly replaced with a new abstract, which Applicants submit is within the 50-150 word limit. As such, Applicants respectfully request withdrawal of this objection.

Claim Rejections-35 U.S.C. §102

Qian

Claims 79 and 81 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,047,028 (“Qian”). Applicants respectfully traverse the rejection of claims 79 and 81 based on Qian, since this reference does not disclose each and every element recited in these claims.

In particular, Applicants disagree with the Examiner’s definition of the term “ablation” as “including the surgical excision or amputation of body or tissue by . . . coagulating,” for the simple reason that, during the coagulation process, tissue is not removed—but rather is transformed from one state to another. Thus, although Qian does teach forming a thrombosis, this is not the same as ablating tissue, which requires the removal of tissue.

Thus, Applicants submit that claims 79 and 81 are not anticipated by Qian, and as such, respectfully request withdrawal of the rejections of these claims.

Rexroth

Claims 82-84 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,943,290 (“Rexroth et al.”). Applicants respectfully traverse the rejection of claims 82-84 based on Rexroth, since this reference does not disclose each and every element recited in these claims.

In particular, the electrosurgical apparatus 10 of Rexroth et al. is not disclosed as being connectable to a source of electrolyte fluid, as required by independent claim 82. Rather, the electrosurgical apparatus 10 has an electrically non-conductive fluid source 14 that is connectable to an electrically non-conductive fluid source 14 (col. 7, lines 24-31). In fact, the electrosurgical apparatus is used to remove electrolyte fluid from a surgical site during the surgical procedure by delivering, under pressure, a non-conductive fluid through the electrosurgical apparatus to the tissue region, in order to provide a more efficient electrosurgical process (see Abstract).

Thus, Applicants submit that claims 82-84 are not anticipated by Rexroth et al., and as such, respectfully request withdrawal of the rejections of these claims.

Claims-Allowance

Applicants graciously acknowledge the allowance of claims 70 and 72-78.

New Claims

Applicants submit that newly added claims 85-87 find support in the specification, as originally filed, and are patentable over the prior art of record. In particular, claim 85 should be patentable by virtue of its dependency from allowable independent claim 70, and claims 86 and 87 should be patentable by virtue of their respective dependencies from independent claims 79 and 82, which Applicants believe are allowable.

Conclusion

Based on the foregoing, all claims pending in the application are believed to be allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (714) 830-0600.

Respectfully submitted,

BINGHAM MCCUTCHEN LLP

Dated: March 22, 2004

By: 

Michael J. Bolan
Reg. No. 42,339

Bingham McCutchen LLP
Three Embarcadero Center
San Francisco, California 94111